

REMARKS

Applicant respectfully traverses the rejections made in the Office Action mailed November 18, 2005 in the above-identified case. Applicant believes that none of the rejections establish the obviousness of the respective claims. Thus, Applicant respectfully requests that Examiner withdraw the rejections and allow all of the pending claims.

*Office Action Section 2*

Applicant respectfully submits that claims 1, 6, 12, and 61 are nonobvious over Adams Jr. (5,866,260) in view of Calabrese (2,657,795) and Hurst (3,900,102). Applicant believes that Hurst is an improper reference because it is non-analogous art. Moreover, Applicant believes that even if all three references were valid references, their combination would not produce the inventions of claims 1, 6, 12, and 61. Finally, Applicant believes that Examiner has not sufficiently shown that one skilled in the art would be motivated to combine the three cited references.

*a. Hurst is non-analogous art.*

As set forth in Applicant's Appeal Brief filed in response to the Final Office Action mailed November 17, 2005 (in the context of the Tachauer reference<sup>1</sup>), only prior art that is *analogous* to the claimed invention is within the scope of relevant prior art in an obviousness determination. *In re Clay*, 966 F.2d 656, 658 (Fed. Cir. 1992). Prior art is analogous when it (a) "is from the same field of endeavor" or (b) "is reasonably pertinent to the particular problem

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<sup>1</sup> Because Examiner no longer relies on the Tachauer reference as a basis for rejection, Applicant infer that Examiner was persuaded that the Tachauer reference was non-analogous art.

with which the invention is involved.” *Id.* at 658-59. Applicant respectfully submits that Hurst satisfies neither of those criteria.

Applicant believes that Hurst is not from the same field of endeavor as the inventions of claims 1, 6, 12, and 61. As noted in the Appeal Brief, the field of endeavor of the inventions of claims 1, 6, 12, and 61 is transparent window panes carrying removable protective coverings or maskings. (Application at p. 1, ll. 6-9.) In contrast, Hurst’s field of endeavor is waterproof sealants for “concrete structures” and other “buildings and civil engineering structures.” (Hurst at col. 1, ll. 11, 16-17.) These fields of endeavor are clearly not the same.

Moreover, Applicant believes that Hurst is not reasonably pertinent to the particular problem with which the inventions of claims 1, 6, 12, and 61 are involved. As the Federal Circuit has instructed, “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *Clay*, 966 F.2d at 659. The present application states the problem addressed by the inventions of claims 1, 6, 12, and 61 as follows:

The panes of an IG unit, as well as monolithic panes, can be damaged or soiled while being transported to a building site, or during the installation and building process. The installation and building process typically involves the efforts of a variety of crafts people, such as carpenters, masons, and painters. During such processing, the pane or panes can be inadvertently scratched or covered with paint, stain, or other finishing materials. Therefore, it is advantageous to temporarily mask the surface of a pane during periods of transportation, installation, and building.

(Application at ¶ 4.) On the other hand, Hurst addresses problems associated with applying “a membrane of a bituminous composition or the like” to a concrete-like surface.<sup>2</sup> (Hurst at col.1, ll. 18-52.) Applicant believes that a glass or window manufacturer would simply not be logically drawn to a reference like Hurst, meaning that Hurst is not reasonably pertinent to the particular problem with which claims 1, 6, 12, and 61 are involved.

Applicant believes that because Hurst is neither from the same field of endeavor nor reasonably pertinent to the relevant problem, Hurst is “too remote to be treated as prior art.”

*Clay*, 966 F.2d at 658 (internal quotations omitted). Accordingly, Applicant respectfully requests that Examiner withdraw this rejection and allow claims 1, 6, 12, and 61.

*b. The cited combination would not produce the claimed invention.*

Even if all the references cited by Examiner in rejecting claims 1, 6, 12, and 61 were valid references, Applicant submits that the cited combination would not result in the claimed invention. Claims 1, 6, 12, and 61 recite “strips of transparent or translucent masking film [that] are disposed in a sequentially overlapping fashion with each subsequent strip overlapping a portion of a preceding strip, such that the overlapped strips . . . *define a plurality of exposed lateral edges that form readily accessible means for removing the protective covering from the window pane.*” Examiner concedes that Adams Jr. lacks this element. Applicant respectfully submits that neither Hurst nor Calabrese disclose this element either.

Calabrese does not disclose strips of masking film disposed in a sequentially overlapping fashion. Indeed, Calabrese describes its “composite striping tape”<sup>3</sup> as “being in edge-to-edge

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<sup>2</sup> Examples include ensuring a uniform thickness and handling the membrane while hot. (Hurst at col. 1, ll. 36-52.)

<sup>3</sup> Like Hurst, Calabrese makes no mention of window panes. Instead, Calabrese relates to “the masking of surfaces *prior to painting of stripes and similar designs thereon.*” (Calabrese at col. 1, ll. 3-4.) Thus, Calabrese is also likely non-analogous art.

relationship.” (Calabrese at col. 2, ll. 38-39.) Thus, Applicant believes that Calabrese would not lead one skilled in the art to dispose strips of masking film in the claimed overlapping fashion.

Likewise, even if Hurst were a proper prior art reference, it does not disclose disposing strips of masking film in a sequentially overlapping fashion according to claims 1, 6, 12, and 61. First, as noted above, Hurst does not disclose the claimed masking film at all. Rather, Hurst discloses membranes made of bituminous or similar compositions. (Hurst at col.1, ll. 17-22.) Moreover, the membranes of Hurst do not provide the advantage recited in claims 1, 6, 12, and 61—namely, the membranes do not “define a plurality of exposed lateral edges that form said readily accessible means for removing the protective covering from the window pane.” Hurst mentions nothing like this limitation. Indeed, why would membranes used to waterproof concrete-like structures need to be readily removable? Thus, Applicant believes that Hurst would not lead one skilled in the art to dispose the claimed strips of masking film in the claimed overlapping fashion. Thus, Hurst does not cure the deficiencies of Adams Jr. and Calabrese, and Applicant’s invention as claimed would not be the result of the cited combination of references. Accordingly, Applicant respectfully requests that Examiner withdraw this rejection and allow claims 1, 6, 12, and 61.

*c. Examiner’s bases for finding a motivation to combine are flawed and fail to present a prima facie case of obviousness.*

Applicant believes that Examiner’s two bases for finding a motivation to combine Calabrese and Hurst with Adams Jr. are flawed. With respect to Calabrese, Examiner states that “having the multiple strips of masking material disposed over a large central portion of a first surface would protect the central portion of the structure from being painted thereon as taught by Calabrese.” But Examiner’s premise is flawed because painting a striped or similar pattern on a

structure, as taught in Calabrese, results in much of that structure's central portion being painted on. Thus, Calabrese does not teach protecting a central portion from being painted on. With respect to Hurst, Examiner states that the teachings of Hurst "would allow for the formation of a continuous membrane." But Adams Jr.'s single sheet of masking material already provides for a continuous membrane. If one skilled in the art wanted only a continuous membrane, he or she would be satisfied with Adams Jr. and would not be motivated to combine it with anything from Hurst. Thus, because Examiner's bases for finding a motivation to combine the cited references are flawed, Applicant believes that Examiner has not sufficiently shown that one skilled in the art would be motivated to combine the three cited references and therefore has failed to state a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests that Examiner withdraw this rejection and allow claims 1, 6, 12, and 61.

### *Office Action Section 3*

Applicant respectfully submits that claims 1, 6, 12, and 61 are nonobvious over Nagashima (6,461,736) in view of Adams Jr. Examiner cites components 3, 4, and 5 of Nagashima as being a plurality of strips of masking material. But as the Nagashima specification makes plain, components 3, 4, and 5 are thin film coatings, which are essentially an integral part of the glazing panels, and not masking material. (Nagashima at col. 18, ll. 4-17 (calling component 3 "a transparent conductive film," component 4 "an amorphous silicon layer," and component 5 "a metal electrode layer").) The specification of the present application clearly distinguishes masking material from thin film coatings. (*E.g.*, Application at ¶ 38 ("While the masked outer surface 14 of this pane 2A is not shown as having any thin film coating, it is anticipated that the masking material of this invention will be applied over coated surfaces of

monolithic panes and IG units.”).) Accordingly, because Examiner apparently misread Nagashima or misapplies its teaching, Applicant respectfully requests that Examiner withdraw this rejection and allow claims 1, 6, 12, and 61.

*Office Action Section 4*

Applicant respectfully submits that claims 8-11 stand in condition for allowance because they all depend from claim 1, which Applicant believes stands in condition for allowance.

*Office Action Section 5*

Applicant respectfully submits that claims 48-51 and 55 are nonobvious over Adams Jr. in view of Calabrese, Bargados, and Emmanuel (5,836,119). Applicant believes that combining the cited references would not lead to the claimed inventions. Specifically, none of the cited references disclose “at least one peripheral side portion of the protective covering [that] extends beneath a confronting surface of the frame but does not extend so far beneath the frame as to engage the glazing compound.” Examiner contends that Bargados discloses this element, but Bargados suffers from the same deficiency as the Smith reference that was cited against these claims in the Office Action mailed November 17, 2005 and subsequently withdrawn.<sup>4</sup> Namely, Bargados discloses a “plastic window guard” 24 that *does not* extend beneath the disclosed frame 14. Rather, Bargados’s plastic window guard 24 fits within an upper portion of an “elastomeric mount” 18, while only the lower portion of the elastomeric mount 18 extends beneath the frame 14. Thus, because neither Bargados nor any of the other three cited references disclose masking

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<sup>4</sup> Applicant addressed the deficiencies of the Smith reference in the Appeal Brief filed earlier in prosecution of the present application. Because Examiner no longer relies on the Smith reference as a basis for rejection, Applicant infer that Examiner was persuaded that the Smith reference did not disclose the claimed features for which it was cited. Further, Applicant submits that the deficiencies of Bargados are substantially the same as those of Smith.

material extending beneath a confronting surface of a glazing assembly frame, Applicant believes that combining the cited references would not produce the claimed inventions. Accordingly, Applicant respectfully requests that Examiner withdraw this rejection and allow claims 48-51 and 55.

*Office Action Section 6*

Applicant respectfully submits that claim 56 is nonobvious over Adams Jr. in view of Calabrese, Bargados, and Emmanuel. Applicant believes that combining the four cited references would not result in the claimed invention. Specifically, the references fail to disclose at least two claim elements. First, as demonstrated above, neither Bargados nor any of the other three references disclose “at least one peripheral side portion of the protective covering [that] extends beneath a confronting surface of the frame.” Additionally, none of the cited references disclose an IG unit in which “glazing compound is located between the frame and the outer surface of the first pane but not between the frame and outer surface of the second pane.”

Examiner points to figure 3 of Emmanuel as disclosing this limitation, but that figure actually shows glazing compound between both panes and the frame. That is, figure 3 of Emmanuel discloses glazing compound 83 between the frame 20 and the outer surface of the right pane 46 and between the frame 20 and the outer surface of the left pane 46. Thus, because the cited combination lacks two claim elements, Applicant respectfully requests that Examiner withdraw this rejection and allow claim 56.

*Office Action Section 7*

Applicant respectfully submits that claims 57-60 stand in condition for allowance because they all depend from claim 56, which Applicant believes stands in condition for allowance.

*Office Action Section 8*

Applicant respectfully submits that claim 62 is nonobvious over Adams Jr. in view of Schlicht (5,123,211) in view of Emmanuel. Applicant believes that Schlicht—like Hurst and the Tachauer reference—is non-analogous art. Schlicht is neither from the same field of endeavor as the invention of claim 62 nor reasonably pertinent to the particular problem with which it is involved, so Applicant believes that Schlicht is “too remote to be treated as prior art.” *Clay*, 966 F.2d at 658 (internal quotations omitted).

Applicant believes that Schlicht is from a different field of endeavor than that of the invention of claim 62. Schlicht’s field of endeavor is decorative glazing panels for doors (Schlicht at col. 1, ll. 7-8), whereas claim 62’s field of endeavor is transparent window panes carrying removable protective coverings or maskings. These two fields of endeavor clearly differ.

Moreover, Applicant believes that Schlicht is not reasonably pertinent to the particular problem with which the invention of claim 62 is involved. Schlicht is involved with easily installing and/or replacing “trim panels” to create various decorative glazing panel configurations for doors. (Schlicht at col. 1, ll. 35-45.) The invention of claim 62, on the other hand, is involved with temporarily masking glass panes for protection during periods of transportation, installation, and building. A glass or window manufacturer seeking a better way

to temporarily protect glass panes simply would not be logically drawn to a reference like Schlicht. Thus, because Schlicht is neither from the same field of endeavor as the invention of claim 62 nor reasonably pertinent to the particular problem with which it is involved, Applicant believes that Schlicht is non-analogous art. Accordingly, Applicant respectfully requests that Examiner withdraw this rejection and allow claim 62.

### CONCLUSION

In view of the foregoing, Applicant respectfully submits that this application stands in condition for allowance. Applicant respectfully requests favorable consideration and prompt allowance. Applicant believes that no fee is due, as Applicant has not amended the claims. However, the Commissioner is hereby authorized to charge any additional filing fees required to • Deposit Account No. 061910. Examiner is invited to telephone the undersigned if believed to be useful to advance prosecution.

Respectfully submitted,

Dated: February 10, 2006

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